

207187US2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

SAKAE ISHIKAWA ET AL.

: GROUP ART UNIT: 3653

SERIAL NO: 09/848,764

FILED: MAY 4, 2001

: EXAMINER: BUTLER, M.

FOR: METHOD OF AND SYSTEM FOR MANAGING RACK OPERATION, METHOD
OF AND SYSTEM FOR MANAGING MULTISTAGE RACK, . . .

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5-8-03

Election

PROVISIONAL ELECTION OF SPECIES

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicants first wish to thank Examiner Butler for the April 25, 2003 telephone interview at which time the outstanding Election/Restriction Requirement was discussed. During the interview, Applicants took the position that an election of claims for examination on the merits was made in the Provisional Election filed October 30, 2002, and the Provisional Election filed January 31, 2003. The examiner explained that because the restriction requirement was changed in response to our provisional election of October 30, 2002, the election filed January 31, 2003 should not have traversed the election/restriction requirement. When Applicants explained that the new election/restriction was believed to be improper, the examiner took the position that we would have to renew our traversal by submitting new arguments rather than incorporating the arguments of the October 30, 2002 provisional election.

Therefore, in response to the Restriction requirement dated October, 2, 2002, Applicants elect Invention I, Claims 1-38 and provisionally elect species I of Figures 1-5 for

examination on the merits, and identify Claims 1-11 as reading on the elected species.

Applicants respectfully traverse the election of species requirement for several key reasons.

First, the outstanding Official Action merely includes the conclusory statement that “the application contains claims directed to ... patentably distinct species ...” without stating any basis whatsoever in support of such a finding. This is in violation of MPEP §816, which states:

MPEP §816

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ...

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

MPEP § 806.04(f)

Claims to be restricted to different species must be mutually exclusive...

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics. Applicants therefore further traverse the outstanding election requierment on that basis.

Finally, MPEP § 803 states:

MPEP § 803

... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or

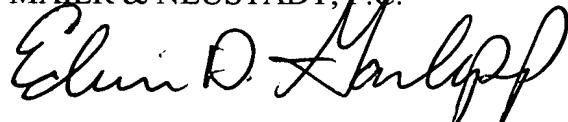
independent inventions.

However, the outstanding Restriction Requirement has not established that an undue burden would exist if the Restriction Requirement was not issued and all the claims were examined together. Moreover, the claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicants respectfully also traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 1-38 be conducted.

Respectfully submitted,

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RE: U.S. Application
Serial No: 09/848,764
Filed: May 4, 2001
Inventor: Sakae Ishikawa et al.
For: Method of and System for Managing Rack . . .

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION OF SPECIES

Our check in the amount of \$ -0-- is attached covering any required fees. In the event that any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is attached.

Respectfully submitted,

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